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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/880,173	06/13/2001	Tomoyuki Asano	09792909-5110	7206

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SONNENSCHN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER

POINVIL, FRANTZY

ART UNIT PAPER NUMBER

3628

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/880,173	ASANO, TOMOYUKI	
	Examiner	Art Unit	
	Frantzy Poinvil	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17, 18, 20-22, 24-26 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17, 18, 20-22, 24-26 and 28-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The present amendment contains two claim 29. It appears that such is a typographical error on the part of the applicant. The second occurrence of claim 29 depends on independent claim 25 should be a system claim because of its dependence to claim system claim 25. The second occurrence of claim 29 should be renumbered as claim 31. The applicant is advised to make the appropriate correction in a future correspondence to this Office action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 18, 20-22, 24-26 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fox et al. (US Patent No. 6,560,581).

As per claims 17, 21 and 25, Fox et al disclose a system and method for accounting for a fee concerning service provided to a user by a service provider such as a merchant. The system and method comprise step or means for:

Receiving from the service provider a charge collection request based on a service request sent from the user to the service provider;

Informing the charge collection to the user based on the charge collection request received from the service provider and

Verifying validity of the charge based on the service request and digital signature based on the service request.

Applicant is referred to column 24, line 31 to column 26, line 2 of Fox et al.

Fox et al does not explicitly teach "when an objection to the fee is received from the user", performing the verifying function. As per this limitation, the Examiner asserts that in most transactions, the consumer is usually presented with a statement acknowledging a purchase order or verifying that the costs or charges made by a merchant are correct before proceeding with making an actual payment. An objection to the costs, charges or fees would have then been made by the purchaser or buyer in the case of a conflict or dispute of the charges. Performing the same function in the system of Fox et al. would have been obvious to one of ordinary skill in the art in order to prevent disputes between all involved parties in the transaction.

As per claims 18 and 20, 22 and 24, 26 and 28, Fox et al disclose the service request and the digital signature are provided from the user and/or from the service provider. Note also column 24, line 31 to column 26, line 2 of Fox et al.

Applicant's representative has amended independent claims 17, 21 and 25 by incorporating features of respective claims 19, 23 and 27 therein and now recite "wherein the service requests and the digital signature for verifying are provided via a storage medium connectable to a user terminal" and argued that Fox et al fail to teach or suggest this limitation.

In response, Fox et al are directed to a system and method for facilitating electronic payments between a consumer and a service provider or merchant providing goods/services to the consumer. In so doing, Fox et al teach that each entity, the consumer and the service provider is connected to a server via a communication system, registers to a certified binding server that all participants trust for verifying service requests and digital signature. See column 5, line 62 to column 6, line 20. Fox et al state:

"During the registration process (FIG. 1), the computing units 24(a)-24(c) at the participants 22(a)-22(c) are each programmed to generate and send a registration packet over the communication system (as represented by communication paths 30(a)-30(c)) to the credential binding server 28 at the trusted credential authority 26. The credential binding server 28 is programmed to produce unique credentials for each participant based upon their registration packets and to send the credentials 32(a)-32(c) back over the communication system (as represented by communication paths 34(a)-34(c)) to the multiple computing units 24(a)-24(c). These credentials are digitally signed by the trusted credential authority and will be used to identify and authenticate other participants during the commerce transaction. It is noted that the registration process requires interaction between each participant and the trusted credential authority".

From this passage, it is clearly seen that the service requests and the digital signature for verifying are provided via a storage medium connectable to a user terminal. Fox et al further state:

"Each commerce transaction has at least one originating participant and one or more recipient participants. A computing unit 24(a) at the originating participant 22(a) is programmed to request and receive the credentials of all intended recipient computing units 24(b) and 24(c). The originating computing unit also verifies the credentials by checking the digital signature of the trusted credential authority. The originating computing unit 24(a) then generates commerce document(s) 36 and commerce instrument(s) 38 that are appropriate for the type of commercial transaction. The document(s) and instrument(s) are both encrypted and sent together over a communication path 40 to the computing unit 24(b) at the first recipient participant 22(b). The document(s) and instrument(s) are encrypted using appropriately different keys so that only the participants to whom the document(s) or instrument(s) pertains can decrypt them. "

Thus, Fox et al teach verifying validity of the charge based on a service request and digital signature generated based on the service request and wherein the service requests and the digital signature for verifying are provided via a storage medium connectable to a user terminal.

Again, the only difference between Fox et al and the claimed invention is that the verifying function is done regardless an objection to the fee is received from the user. Performing the verifying function only when an objection to the fee is received from the user would have been obvious to one of ordinary skill in the art to do when viewing the system and method of Fox et al in order to instantly clarify terms and conditions of payments between the different participants involved in a transaction so as to avoid future financial disputes.

The Examiner refers the applicant to column 24, line 31 to column 26, line 2 and a further reading of columns 22-30 of Fox et al for further teachings of the applicant's newly added limitations.

As per claims 28-30, the service request and the digital signature for verifying are provided from the service provider and the storage medium comprises hardware. See column 7, lines 8-25 and columns 22-30 of Fox et al.

Conclusion

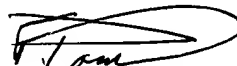
3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sam Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frantzy Poinvil
Primary Examiner
Art Unit 3628

FP
March 28, 2006